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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91219185
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 86276533  
Mark: PrettyWoman  
Published: November 4, 2014

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Uptown Wink LLC )  
(a Tennessee limited liability company) )  
Opposer, )  
v. )  
Procop International NV )  
(a Curaçao naamloze vennootschap (nv) )  
Applicant. )  
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OPENING TRIAL BRIEF  
OF OPPOSER UPTOWN WINK LLC

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Opposer Uptown Wink LLC (“Opposer”), pursuant to 37 C.F.R. § 2.128, respectfully submits Opposer’s Opening Trial Brief, requesting that the United States Trademark Trial and Appeal Board (the “Board”) refuse registration of U.S. Trademark Application Serial No. 86276533 (the “Application”) for the mark PrettyWoman, filed by Applicant Procop International NV (the “Applicant”) in International Class 35 for “promoting the goods and services of others by providing a website featuring advertisements, banners and links to the websites of others in the field of adult-themed products, services and entertainment; providing dissemination of advertising for the goods and services of others via a global computer network; providing commercial directory information in the area of adult-themed products, services and entertainment via a global computer network; providing an on-line computer database in the field of locating and describing adult-themed products via a global computer network,” and claiming a date of first use and a date of first use in U.S. commerce of April 1, 2014.

## **I. DESCRIPTION OF THE RECORD**

The record consists of Opposer’s Notice of Reliance filed February 8, 2016 (the “Notice of Reliance”), Docket No. 11. Applicant submitted no evidence in this proceeding.

The Notice of Reliance comprises printouts of information from the electronic database records of the U.S. Patent and Trademark Office consisting of copies obtained from the Office’s Trademark Electronic Search System (TESS), along with, in the case of Exhibit 1, a copy of records from the Assignment database showing an assignment to the current owner of the registration:

- a. U.S. Trademark Registration No. 2648569, registered November 12, 2002, for the mark PRETTY WOMAN for “Nail and manicure products, namely, artificial fingernails; nail enhancement kits comprised of fingernail art and design products for use on fingernails, namely, stickers,” in International Class 3, and for “Manicure

implements, namely, fingernail files and buffers, artificial nail applicator sticks, pedicure files and buffers, and adhesive applicator stick” in International Class 8, based on use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. Section 1051(a) (Exhibit 1);

- b. PRETTY WOMAN under U.S. Trademark Registration No. 4226100, registered October 16, 2012, in International Class 3 for “Fragrances for personal use, perfumes, toilet water”; (Exhibit 2);
- c. PRETTY WOMAN under U.S. Trademark Registration No. 3915205, registered February 1, 2011, in International Class 4 for “candles”; (Exhibit 3);
- d. PRETTY WOMAN under U.S. Trademark Application No. 86273783, applied for on May 7, 2014, in International Class 25 for “Clothing, namely, t-shirts, shirts, tank tops, sweat shirts, sweat pants, sweat suits, jeans, pants, shorts, overalls, jumpsuits, skirts, dresses, blouses, jackets, sweaters, vests, swimwear, bathing suits, cover-ups, sleepwear, pajamas, robes, nightgowns, leotards, lingerie, panties, bras, boxer shorts, underwear, scarves, belts, socks, stockings, tights, leggings, gloves; outerwear, namely, coats and raincoats; headgear, namely, hats, caps, headbands, visors and bandanas; footwear, namely, shoes, slippers, boots, sandals, flip-flops, and athletic shoes; (Exhibit 4);
- e. PRETTY WOMAN under U.S. Trademark Application No. 85930608, applied for on May 13, 2013, in International Class 3 for “Nail polish; nail enamels; nail polish top coat; nail polish base coat; nail care preparations; cuticle oils; cuticle cream; nail conditioning lotions; hand creams; nail hardeners; nail polish remover; lipstick; lip gloss; lip liner; lip balm;” (Exhibit 5).

The Notice of Reliance also includes Opposer's First Set of Interrogatories dated June 26, 2015 and Applicant's responses thereto dated September 29, 2015 (Exhibit 6), as well as Opposer's First Request for Production of Documents and Things dated June 26, 2015 and Applicant's responses dated September 29, 2015 (Exhibit 7).

## **II. STATEMENT OF THE ISSUE**

Under the test set forth by *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177U.S.P.Q. 563 (C.C.P.A. 1973), given that Applicant's mark PrettyWoman is identical to Opposer's mark PRETTY WOMAN, and the applied for services of Applicant are related to the goods of Opposer, is Applicant's mark likely to cause confusion, mistake, or deception as to the source, origin, association, or sponsorship of Applicant's services within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d)?

## **III. STATEMENT OF FACTS**

Opposer's registered goods under two incontestable registrations for its PRETTY WOMAN trademark include "Nail and manicure products, namely, artificial fingernails; nail enhancement kits comprised of fingernail art and design products for use on fingernails, namely, stickers," in International Class 3, and "Manicure implements, namely, fingernail files and buffers, artificial nail applicator sticks, pedicure files and buffers, and adhesive applicator stick" in International Class 8, under U.S. Trademark Registration No. 2648569, filed April 9, 2001, and registered November 12, 2002, and "candles" in International Class 4 under U.S. Trademark Registration No. 3915205, filed April 9, 2007, and registered February 1, 2011.

Opposer's registered goods for its PRETTY WOMAN trademark further include "Fragrances for personal use, perfumes, toilet water" in International Class 3, under U.S. Trademark Registration No. 4226100, filed September 4, 2005, and registered October 16, 2012.

Moreover, Opposer's applied for goods for its PRETTY WOMAN trademark under pending applications which are prior to any date which Applicant can claim include "Nail polish; nail enamels; nail polish top coat; nail polish base coat; nail care preparations; cuticle oils; cuticle cream; nail conditioning lotions; hand creams; nail hardeners; nail polish remover; lipstick; lip gloss; lip liner; lip balm" in International Class 3 under Application No. 85930608, filed May 13, 2013, and "Clothing, namely, t-shirts, shirts, tank tops, sweat shirts, sweat pants, sweat suits, jeans, pants, shorts, overalls, jumpsuits, skirts, dresses, blouses, jackets, sweaters, vests, swimwear, bathing suits, cover-ups, sleepwear, pajamas, robes, nightgowns, leotards, lingerie, panties, bras, boxer shorts, underwear, scarves, belts, socks, stockings, tights, leggings, gloves; outerwear, namely, coats and raincoats; headgear, namely, hats, caps, headbands, visors and bandanas; footwear, namely, shoes, slippers, boots, sandals, flip-flops, and athletic shoes" in International Class 25, under U.S. Trademark Application No. 86273783, filed May 7, 2014.

In the opposed Application for the mark PrettyWoman, filed on May 9, 2014, Applicant has applied for the following services in Class 35: "promoting the goods and services of others by providing a website featuring advertisements, banners and links to the websites of others in the field of adult-themed products, services and entertainment; providing dissemination of advertising for the goods and services of others via a global computer network; providing commercial directory information in the area of adult-themed products, services and entertainment via a global computer network; providing an on-line computer database in the field of locating and describing adult-themed products via a global computer network."



Applicant based the Application solely on alleged use in United States commerce since April 1, 2014, under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a).

However, in Applicant's responses to Opposer's First Set of Interrogatories, Applicant contradicted its claim of such date of first use in United States commerce and, admitting that it has made no sales under its applied for mark, admits that it has not used the mark in commerce:

**“INTERROGATORY NO. 6**

State the date of the first provision in United States commerce of any services under Applicant's Mark.

See General Objections. April 01, 2014.

**INTERROGATORY NO. 7**

State the date of the first sale in United States commerce of any services under Applicant's Mark.

See General Objections. No sales yet.

**INTERROGATORY NO. 8**

Describe the services sold in Applicant's first sale in United States commerce of services under Applicant's Mark.

See General Objections. No sales yet.

**INTERROGATORY NO. 9**

Identify to whom the first sale in United States commerce of services under Applicant's Mark was made.

See General Objections. No sales yet.”

(See Exhibit 6 to the Notice of Reliance.)

Accordingly, Applicant's claimed date of first use in commerce is false, and the earliest date on which Applicant can rely for purposes of determining priority in this Opposition is the filing date of the Application, that is, May 9, 2014.

**IV. ARGUMENT**

The mark Applicant seeks to register is identical to Opposer's Mark, and Applicant's

services are related to Opposer's goods. Given this, the consuming public is likely to associate the services of Applicant under the mark PrettyWoman with Opposer and with Opposer's goods under its mark PRETTY WOMAN. Thus, any use of the mark PrettyWoman by Applicant is likely to cause confusion, cause mistake or deceive the public in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

**A. OPPOSER HAS STANDING TO BRING THIS OPPOSITION, AND OPPOSER'S MARK ENJOYS PRIORITY OVER APPLICANT'S MARK**

As aforementioned, the filing date of Opposer's incontestable Trademark Registration No. 2648569 is April 9, 2001, and the filing date of Opposer's incontestable Trademark Registration No. 3915205 is April 9, 2007. The filing date of each of Opposer's registrations and pending applications for its mark PRETTY WOMAN predates Applicant's filing date for its Application.

Opposer's prior use of its PRETTY WOMAN trademark and its prior registrations and pending applications for its mark establish both standing to oppose and priority over Applicant's mark. *Rosso and Mastracco, Inc. v. Giant Food, Inc.*, 720 F.2d 1263, 1265, 219 U.S.P.Q. 1050, 1052 (Fed. Cir. 1983); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1028-29, 213 U.S.P.Q. 185, 189-90 (C.C.P.A. 1982).

**B. APPLICANT'S MARK IS IDENTICAL TO OPPOSER'S MARK AND IS LIKELY TO CAUSE CONFUSION BECAUSE APPLICANT'S SERVICES ARE RELATED TO OPPOSER'S GOODS**

The likelihood of confusion between two marks must be based on an analysis of the relevant factors articulated in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). The two key factors in any *du Pont* analysis are the similarities between the marks and the relatedness of the respective parties' goods and services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 U.S.P.Q. 24, 29 (C.C.P.A. 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

First, the marks must be compared for similarities in appearance, sound, connotation and commercial impression. Second, the goods and services of the respective marks must be compared to determine if they are related or if the activities surrounding their marketing are such that confusion of origin is likely. *In re August Storck KG*, 218 U.S.P.Q. 823 (T.T.A.B. 1983).

In the opposed Application in this instance, the mark PrettyWoman is depicted in standard characters, and therefore may, if allowed to register, appear in any typeface, including all capital letters as in Opposer's Mark PRETTY WOMANs. See *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 U.S.P.Q.2d 1253, 1258-59 (Fed. Cir. 2011) (“[T]he registrant is entitled to depictions of the standard character mark regardless of font style, size, or color.”).

Accordingly, as a matter of law, Applicant's mark is identical to Opposer's Mark.

In assessing the relatedness of the goods and services of the respective parties, the more similar the marks at issue, the less similar the goods or services need to be to support a finding of likelihood of confusion. *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 U.S.P.Q.2d 1687, 1689 (Fed. Cir. 1993). If, as here, the marks of the respective parties are identical or virtually identical, the relationship between those goods and services need not be as close to support a finding of likelihood of confusion as would be the case if the two marks differed from one another. *Id.* at 1207.

Moreover, it is well recognized that confusion may be likely to occur from the use of the same or similar marks for goods, on the one hand, and for services involving those goods, on the other. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 U.S.P.Q.2d 1025 (Fed. Cir. 1988); *In re U.S. Shoe Corp.*, 229 U.S.P.Q. 707 (TTAB 1985). Relatedness is a given when the applied for services of one party can encompass the goods of the other party. *In re Coors*

*Brewing Co.*, 343 F.3d 1340, 1347, 68 U.S.P.Q.2d 1059, 1064 (Fed. Cir. 2003); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 U.S.P.Q.2d 1001, 1005 (Fed. Cir. 2002).

Applicant's services, promoting of the goods and services of others and providing dissemination of advertising for the goods and services of others via a global computer network, are unlimited as to the types of goods of others so promoted and advertised, and therefore can include promoting and advertising goods which are the same as Opposer's goods. Thus, Applicant's applied for services are clearly related to Opposer's goods.

## **V. CONCLUSION**

The mark Applicant seeks to register is identical to Opposer's Mark.

Applicant's services are related to Opposer's goods.

Given this, the consuming public is likely to associate the services of Applicant under the mark PrettyWoman with Opposer and with Opposer's goods under its mark PRETTY WOMAN, or to believe that Applicant's services are sponsored, endorsed or licensed by Opposer. Therefore, any use of the mark PrettyWoman by Applicant is likely to cause confusion, cause mistake or deceive the public in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

Accordingly, Opposer respectfully requests that this Opposition be sustained and that the registration sought by Application Serial No. 86276533 be refused as to all of the applied for services in International Class 35.

Dated: July 22, 2016

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## CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Opposer's Opening Trial Brief has been forwarded via email to Applicant's attorney of record as follows:

JEFFREY M. FURR  
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on this 22nd day of July, 2016.

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/s/  
William J. Seiter